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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,223	11/18/2003	Takahiro Nakajima	11197/5	3150

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/830,223	Applicant(s) NAKAJIMA ET AL.	
	Examiner J. Pasterczyk	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>5/21/04</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. This Office action is in response to the telephonic interview of 5/21/04 with David Wallace, Esq., and the hand-carried PTO -1449 with accompanying prior art and memo from Mr. Wallace received 5/24/04. As per the interview, the courtesy copy of the specification, claims and abstract dated 11/18/03 will be henceforth used by this examiner for all purposes since the amended claims filed 1/21/03 would have made many of the claims indefinite; this latter amendment will be disregarded. The examiner notes that the contents of this courtesy copy are identical to the matter scanned into the PTO's computerized examination system known as eDAN and dated therein 11/18/03. The prior art will be made of record upon a full examination on the merits. However, c.f. below for issues of lack of unity of invention and several formal issues that should be dealt with before a full examination on the merits is possible.

2. Restriction is required under 35 USC 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I: claims 1, 2, and the embodiments of dependent claims 3 and 5-48 containing independent claim 1, drawn to an ester polymerization catalyst whose activity obeys certain mathematical equations.

Group II: claim 4 and the embodiments of dependent claims 5-48 containing independent claim 4, drawn to a catalyst for polymerizing esters having an aryloxy or arylimido group-containing compound and a metal or metal-containing compound wherein the metal is not antimony or germanium.

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Group III: claim 49 and 50, drawn to an ester polymerization catalyst having two components, neither of which has any substantial activity toward ester polymerization.

Group IV: claim 51, drawn to a polyester made using a catalyst having two components, neither of which has any substantial ester polymerization ability.

Group V: claims 52-58, drawn to polyesters made using the catalysts of any of claims 1-50.

Group VI: claim 59, drawn to a polyester film made using the polyester of any of claims 51-58.

Group VII: claims 60-62, drawn to a hollow molded article made using the polyester of any of claims 51-58.

Group VIII: claims 63-67, drawn to a polyester fiber made using the polyester of any of claims 51-58.

Group IX: claims 68-72, drawn to a method of making polyester using the catalysts of any of claims 1-50.

Group X: claims 73-76, drawn to a method of making terephthalates using a catalyst of any of claims 1-50.

3. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: groups I, II and III are drawn to three different catalysts, each defined by completely different characteristics. Groups IV and V are both drawn to polyesters, but the claim of group IV is a subset of the claims of group V since the latter polyesters may be made using any of the catalysts of groups I-III, while the polyester of group

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IV may be made using only the catalyst of group III. Other than the manner of making these polyesters, they appear to be indistinguishable over any of those already known in the art. The film of group VI, claim 59, is made using a polyester of any of claims 51-58, which appear to be indistinguishable over any polyester known in the prior art. The hollow molded article of group VII, claims 60-62, is made using a polyester of any of claims 51-58, which other than their source appear to be indistinguishable over any of those of the prior art. The polyester fiber of group VIII, claims 63-67, is made using a polyester of any of claims 51-58, which other than their source appear to be indistinguishable over their prior art. The method of making polyester of group IX, claims 68-72, is a separate statutory class of invention under national practice, and could be practiced with another materially different catalyst than any of the three of groups I, II or III of the present invention. The method of making terephthalates of group X, claims 73-76, is a separate statutory class of invention under national practice, and could be practiced with another materially different catalyst than any of the three of groups I, II or III of the present invention.

4. As the recited polyesters, film made using them, fibers made using them, and hollow molded articles made using them do not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate. Since the three different catalysts have no common special technical feature, unity of invention is lacking and restriction is appropriate. Since the methods of making polyesters and terephthalates are conventional absent the catalysts used to make them, the lack unity of invention and restriction is appropriate. The corresponding method of making polyester and method of making terephthalate for whichever catalyst is elected, if

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indeed applicants do elect one of the catalysts, would be rejoinable in further proceedings if the method were drawn to correspond to only one class of catalyst.

5. The examiner wishes to note several other issues that applicants may wish to address in a complete response to this Office action. As intimated above, the present claims make extensive use of multiply dependent claiming, which is barred in national patent practice. This is especially prevalent throughout the dependent claims. In addition, the present claims make extensive use of functional language. This is inconsistent with national practice according to the holding in *ex parte Slob*, 157 USPQ 172 (Bd. Pat. App. & Interf. 1967). This is especially prevalent in the claims to catalysts, particularly claim 1. These claims also use negative language in barring certain metals or other components from the catalysts, particularly claims 2, 4, 49 and 51. This is inconsistent with national practice according to the holding in *ex parte Grasselli*, 231 USPQ 393 (Bd. Pat. App. & Interf. 1983). Finally, claim 1 is not a single sentence as required in national practice; instead it appears to be primarily functional language with a sentence fragment embedded therein. In national practice composition claims are normally recited either by the components or compounds they must contain or in a product-by-process format for when the identities of the separate ingredients become so intermingled as to become indistinguishable in the final product of the process used to make the product.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 8:30 to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700



J. Pasterczyk

AU 1755

5/26/04